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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/682,285

08/14/2001

Eugene Pauling Boden

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07/25/2008

CANTOR COLBURN LLP - SABIC (LEXAN/CYCOLOY)

20 Church Street

22nd Floor

Hartford, CT 06103

EXAMINER

BOYKIN, TERRESSA M

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

07/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/682,285	Applicant(s) BODEN ET AL.	
	Examiner Terressa M. Boykin	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The Interference decision on Priority-Favorable.

With regard to the claims which are now pending, applicants filed a list of claims pending at the time the interference was declared (i.e. 25 claims - even though the copy read "add claims 24-28", and only 24 and 25 were listed) - compare this with the amendment of 4/9/04 which lists 28 claims.

Applicants should file and make clear via a correction of the claims applicants are intending and now pending.

An updated search and review of the application has been made and is as follows:

Claim Rejections - 35 USC § 112

Claims 1-28 (*clarification and correction required: see above*) are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The subject matter on beginning on pages 10 through 12 of applicants' specification regarding each of the parameters X, Y and Z appear to be critical or essential to the practice of the invention, but not included in the claim(s) simultaneously and thus is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The parameters appear to be dependent of one another although set forth as independent embodiments whether in a stirred tank reactor, a batch reactor or a plug flow reactor. Clarification and/or correction is required.

Claims 1-28 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the specific ranges as set forth on pages 10 lines 7-19, does not reasonably provide enablement for *all* water concentrations, *all* methanol concentrations, *all* temperatures and *all* residence times even in view of the equations as expressed for such parameters.

Although applicants have clearly expressed these parameters in terms of the equations as set forth in claims 1, 12 and 17, etc.(albeit individually depending upon the reactor type) there appears to be instances where the values of each of these parameters may fall "outside" of those disclosed as "preferable" on page 10 and have not been shown via an example or discussion that values or parameters outside of those disclosed on page 10 would afford the specific dimethyl carbonate having the characteristics as disclosed by the specific method as claimed.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terressa Boykin whose telephone number is (571) 272- 1069 . The examiner can normally be reached at (571) 272-0580 on Monday through Friday from 9:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck , can be reached at (571) 272- 1078 . The

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fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Terressa M. Boykin/
Primary Examiner, Art Unit 1796